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In re Application of WHITLEY et al
U.S. Application No.: 09/647,028
Int. Application No.: PCT/US99/06429
Int. Filing Date: 24 March 1999
Priority Date: 24 March 1998
Attorney Docket No.: 36968/176363
For: WIRELESS TELEMETRY METHODS AND
SYSTEMS FOR COMMUNICATING WITH
OR CONTROLLING INTELLIGENT DEVICES

DECISION

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 29 May 2002, requesting that the present application be accepted for national stage processing without the signature of one of the joint inventors.

BACKGROUND

On 24 March 1999, applicant filed international application PCT/US99/06429, which claimed priority of an earlier United States application filed 24 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 21 September 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 September 2000 (24 September 2000 was a Sunday).

On 25 September 2000, applicant filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), a declaration executed by one of the three joint inventors, and a petition under 37 CFR 1.47(a).

On 08 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), indicating that a

properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 21 November 2001, this Office mailed a decision dismissing the 25 September 2000 petition under 37 CFR 1.47(a).

On 29 May 2002, applicant filed the present renewed petition along with a declaration executed by one of the previously nonsigning inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied item (1) above. With regard to the declaration executed by Karl Warfel, the USPTO no longer requires a newly executed declaration where the date of execution has been omitted. See MPEP 602.05.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers

should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, the renewed petition fails to state whether inventor Kevin Whitley cannot be located or whether Whitley refuses to sign the application papers. According to the renewed petition, applicant first made an attempt to present a complete copy of the application papers to Whitley by a letter mailed to Whitley's last known address on 19 December 2001 (see Exhibit 4). However, applicant has not provided an affidavit from the person with apparent firsthand knowledge of the correspondence, i.e. Karen Stark. The copy of the returned envelope indicates that Whitley never received the 19 December 2001 letter. Thus, it cannot be concluded at the present time that Whitley refuses to sign documents that he never received. Also, applicant has not provided evidence of any further attempts to reach Whitley, e.g. by telephone, by electronic mail, by facsimile, or by contacting Whitley's family, friends, and former co-workers. Therefore, it cannot be concluded at the present time that Whitley cannot be located.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known addresses of the nonsigning inventor.

CONCLUSION

Because applicant has failed to satisfy item (2) above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" along with the appropriate petition fee. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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